in an amount effective to protect said at least one keratinous fiber from said extrinsic damage or to repair said at least one damaged keratinous fiber, and further wherein said composition is heated to a temperature of at least 100°C during or after application to at least one keratinous fiber.

Remarks

I. Status of Claims

Claims 1-101 and 103-204 are pending in this application. Claims 1-100, 106-114, 116-120, 122, 128, 132-141, 153-160, 162-165, 167, 173, and 178-186 have been withdrawn by the Examiner.

Claims 101, 196, and 200 have been amended. Support for this amendment can be found in the specification at p. 8, line 1. Accordingly, no new matter has been added by these amendments nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment under 37 C.F.R. § 1.116 should allow for immediate action. The proposed amendments, moreover, place the claims in condition for allowance or, at least, in better form for appeal, if necessary.

II. Drawing

Applicants respectfully request that the Examiner acknowledge receipt of the drawing submitted with the Amendment of August 21, 2002.

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III. Rejection under 35 U.S.C. § 102

Claims 101, 103-105, 115, 121, 123-127, 129-131, 142-146, 196-197, and 200-204 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,688,930 ("*Bertho*"). Office Action at pp. 2-3. Applicants respectfully traverse this rejection.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *See In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

The Examiner refuses to give patentable weight to "wherein said composition is heat-activated" because the claim is drawn to a composition rather than a method. Office Action at pp. 2-3. The Examiner further believes that the intended use recitation does not result in a structural difference between the claims and Bertho. *Id.* at p. 2.

Applicants respectfully disagree. "Wherein said composition is heat-activated" does provide a difference to the claimed composition over Bertho. According to the specification, "heating" involves the use of temperatures above 100°C. Specification at p. 8, line 1. A "heat-activated" composition "protects" or "repairs the at least one keratinous fiber better than the same composition which is not heated during or after application of the composition." *Id.* at lines 12-16. Thus, a heat-activated composition is different from one that is not heated. To further clarify "heat-activated" or "heated," Applicants have amended claims 101 and 196 to recite "wherein said composition is

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heat-activated to a temperature of at least 100°C" and claim 200 to recite "wherein said composition is heated to a temperature of at least 100°C."

In contrast, Bertho does not teach such a heat-activated composition. If anything, Bertho teaches away from heat activation. According to Bertho, the use of high temperatures, such as temperatures from 100°C to 150°C, causes staining. Col. 1, lines 40-42 and 46-49. In view of Bertho, one of ordinary skill in the art would not use a heat-activated composition. Thus, *Bertho* does not teach, either explicitly or impliedly, a heat-activated composition for protecting or repairing at least one keratinous fiber according to the present invention.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

IV. Rejection under 35 U.S.C. § 103

Claims 101, 103-105, 115, 121, 123-127, 129-131, 142-152, 161, 166, 168-172, 174-177, and 187-204 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,004,545 ("*Karlen*") in view of U.S. Patent 5,688,930 ("*Bertho '930*") or U.S. Patent No. 6,087,403 ("*Bertho '403*"). Office Action at pp. 3-4. Applicants respectfully traverse.

In the previous Office Action, the Examiner stated that Karlen taught compositions including AMPHOMER LV-71. May 21, 2002 Office Action at pp. 5-6. Moreover, the Examiner alleges that Karlen's compositions "necessarily include a surfactant chosen from a group that includes nonionic surfactants" and notes that "alkylpolyglucosides are particularly preferred." *Id.* at p. 6.

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Applicants respectfully disagree with the Examiner's characterization of Karlen's teachings. Karlen teaches a hair cleansing composition comprising a particular vinyl/silicone copolymer and at least one surfactant selected from the group consisting of nonionic, anionic, cationic, and amphoteric surfactant compounds. Col. 2, lines 15-20. Karlen describes a wide variety of potential surfactants and does not limit the composition to "necessary include" any particular surfactant within the choice described above. Further, Karlen's disclosure of an alkylpolyglucoside does not render the claimed invention obvious. Alkylpolyglucosides are based on a glucose unit, which is a C_6 compound.[1] Thus, alkylpolyglucoside is not encompassed by "at least one compound chosen from C_3 to C_5 monosaccharides."

Moreover, the combination of Karlen and Bertho '930 or Bertho '403 is improper. The Examiner relies on Bertho '930 for teaching mixtures of alkyl glycosides, and on Bertho '403 for teaching emulsifying compositions based on fatty alcohols and polyglycoside mixtures. *Id.* at p. 6. Karlen provides large lists for each class of surfactant. The references, however, whether alone or in combination, fail to provide specific guidance that a particular surfactant, from the large number of possibilities, would especially benefit the alkyl glucoside of Bertho '930 or the polyglycoside mixtures of Bertho '403. Because the references do not show such specific teachings or suggestions, the Examiner has failed to establish a *prima facie* case of obviousness.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

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[1] A glucoside "refers to any glycoside having glucose as its sugar constituent." *Hawley's Condensed Chemical Dictionary*, Thirteenth Edition, Van Nostrand Reinhold, New York, 1997.

V. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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By: Marie Bartlett, Reg. No. 52,576
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Date: April 8, 2003

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APPENDIX: MARKED-UP COPY OF CLAIMS

101. (Twice Amended) A composition for protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage comprising at least one compound chosen from C_3 to C_5 monosaccharides substituted with at least one C_1 to C_{22} carbon chain, wherein said at least one compound is present in an amount effective to protect said at least one keratinous fiber from said extrinsic damage or to repair said at least one damaged keratinous fiber, and further wherein said composition is heat-activated **to a temperature of at least 100°C**.

196. (Twice Amended) A kit for protecting at least one keratinous fiber from extrinsic damage or for repairing at least one keratinous fiber following extrinsic damage comprising at least one compartment,

wherein said at least one compartment comprises a composition comprising at least one compound chosen from C_3 to C_5 monosaccharides substituted with at least one C_1 to C_{22} carbon chain, wherein said at least one compound is present in an amount effective to protect said at least one keratinous fiber from said extrinsic damage or to repair said at least one damaged keratinous fiber, and further wherein said composition is heat-activated **to a temperature of at least 100°C**.

200. (Amended) A composition for protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage comprising at least one compound chosen from C_3 to C_5 monosaccharides substituted with at least one C_1 to C_{22} carbon chain, wherein said at least one compound is present in an amount effective to protect said at least one keratinous fiber from said extrinsic

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damage or to repair said at least one damaged keratinous fiber, and further wherein said composition is heated **to a t mperature of at least 100°C** during or after application to at least one keratinous fiber.

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